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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,848	07/24/2003	Dan Burris	005127.00309	8940
22909	7590	08/29/2005	EXAMINER	
BANNER & WITCOFF, LTD.			PATTERSON, MARIE D	
1001 G STREET, N.W.			ART UNIT	
WASHINGTON, DC 20001-4597			PAPER NUMBER	

3728

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,848

Applicant(s)

BURRIS ET AL.

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-14,27-34 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49 is/are allowed.
- 6) ☒ Claim(s) 1-8,10-14,27-34 and 41-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5-8, 10, 12-14, 27, 30-34, 41, 43, and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Zaino (4447967).

Zaino shows a shoe comprising an upper formed from a substrate comprising a textile material formed from a plurality of filaments or fibers (fabric sock, it is noted that according to Merriam Webster Online dictionary the term “fabric” is defined as “cloth” and “cloth” is defined as “a pliable material made usually by weaving, felting, or knitting natural or synthetic fibers and filaments”) and a web layer with apertures (formed by elements 9-14) which is injection molded onto the substrate layer and the polymer material inherently extends around the plurality of filaments or fibers to secure the web layer (Zaino states “the plastic material sets on the sock and combines securely therewith” (column 1 lines 60-65) and “The plastic structure is indissolubly bonded to the vamp or sock” (column 2 lines 36-40)). During the injection molding process described by Zaino the plastic polymeric material would inherently extend around the plurality of filaments or fibers to secure the web layer.

In reference to claims 11-13, 31, 32, and 46-48, a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA

1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 11, 29, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaino.

3. Zaino as discussed above shows a shoe substantially as claimed except for the exact material for the substrate and the exact polymeric material. Zaino suggests the use of different materials (column 2 lines 40-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a non woven sock fabric and polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

4. Claims 3, 4, 28, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaino in view of Shiomura (4785558) or Bartels (4232458).

Zaino shows a shoe substantially as claimed except for the exact substrate.

Shiomura or Bartels teaches the use of a substrate which comprises two layers which are interconnected by fibers as a material for uppers of footwear. It would have been obvious to use a layered substrate as taught by either Shiomura or Bartels for the substrate in the shoe of Zaino to increase fit and comfort.

5. Claims 8, 10, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaino in view of Sass (3650051).

Zaino shows a shoe substantially as claimed except for ridges. Zaino suggests different vamp shapes (column 2 lines 40-44). Sass teaches providing ridges (26) on a lateral portion of a shoe. It would have been obvious to provide ridges as taught by Sass on the lateral portion of an upper in the shoe of Zaino to allow the shoe to be used for kicking a ball and to control the ball.

Allowable Subject Matter

6. Claim 49 is allowed.

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300

Art Unit: 3728

(FORMAL FAXES ONLY). Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

A handwritten signature in black ink, appearing to read 'Marie Patterson', with a stylized, flowing script.

Marie Patterson
Primary Examiner
Art Unit 3728